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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,481	12/13/2001	Kazutoshi Miyamura	1391.1038	5910
21171	7590	02/08/2006	EXAMINER WON, MICHAEL YOUNG	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT 2155	PAPER NUMBER

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/009,481	Applicant(s) MIYAMURA ET AL.	
	Examiner Michael Y. Won	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/13/01 & 4/21/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed on December 13, 2001.
2. Claims 1-11 have been examined and remain pending with this action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of claims 9 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The applicant(s) claim "a program recording medium to realize" but does not define within the body of the claim the hardware in which the invention runs. Thus, absent recitation of the server or some other hardware, claim 9 is not limited to a tangible embodiment, instead being sufficiently broad to encompass software, per se.

The examiner encourages applicant to define within the claims the embodied features and limitations on a “tangible” computer readable medium such as hard drives, disks, and other hardware elements. An example of a proper format would be “a machine readable code” or “program code”... “stored on a tangible computer readable medium”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freivald et al. (US 5,898,836 A) in view of Schneider (US 6,973,505 B1).

INDEPENDENT:

As per **claim 1**, Freivald teaches a file generation apparatus comprising:

file generating and registering means for generating a file (see Fig.4 and col.7, lines 40-41) and registering the file in a file posting apparatus (see Fig.2 and col.7, lines 2-6); and

transmitting means for transmitting file registration information that describes the URL notation to a transmission destination (see col.7, lines 40-41).

Freivald does not explicitly teach of a URL generating means for generating URL notation that includes a description of full path information to the file registered in the file posting apparatus and a description to call a function, which operates the file.

Schneider teach of a URL generating means for generating URL notation that includes a description of full path information to the file registered in the file posting apparatus and a description to call a function, which operates the file (see col.9, lines 14-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teaching of Schneider within the system of Freivald by implementing generating URL notation that includes a description of full path information to the file registered in the file posting apparatus and a description to call a function, which operates the file within the file generation apparatus because Freivald teaches that URL identifies a document on the web (see col.1, lines 32-35).

As per **claim 9**, Freivald teaches a program-recording medium to realize a file generation apparatus to register a generated file in a file posting apparatus, wherein the program causes a computer to execute:

generating a file (see Fig.4 and col.7, lines 40-41) and registering it in a file posting apparatus (see Fig.2 and col.7, lines 2-6); and

transmitting file registration information describing the URL notation to a transmission destination (see col.7, lines 40-41).

Freivald does not explicitly teach of generating URL notation including a description of full path information to the file registered in the file posting apparatus and

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a description to call a function for manipulating the file. Schneider teach of generating URL notation including a description of full path information to the file registered in the file posting apparatus and a description to call a function for manipulating the file (see col.9, lines 14-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teaching of Schneider within the system of Freivald by implementing generating URL notation including a description of full path information to the file registered in the file posting apparatus and a description to call a function for manipulating the file within the file generation program because Freivald teaches that URL identifies a document on the web (see col.1, lines 32-35).

As per **claim 10**, Freivald teaches an image scanner comprising:

an image processing section to read image data and generating a file (see Fig.4 and col.7, lines 40-41);

file registering means for registering the file in a file posting apparatus (see Fig.2 and col.7, lines 2-6); and

transmitting means for transmitting file registration information describing the URL notation to a transmission destination (see col.7, lines 40-41).

Freivald does not explicitly teach of a URL generating means for generating URL notation that includes a description of full path information to the file registered in the file posting apparatus and a description to call a function, which operates the file.

Schneider teach of a URL generating means for generating URL notation that includes

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a description of full path information to the file registered in the file posting apparatus and a description to call a function, which operates the file (see col.9, lines 14-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teaching of Schneider within the system of Freivald by implementing generating URL notation that includes a description of full path information to the file registered in the file posting apparatus and a description to call a function, which operates the file within the image scanner because Freivald teaches that URL identifies a document on the web (see col.1, lines 32-35).

DEPENDENT:

As per **claim 2**, which depends on claim 1, Freivald further teaches wherein the transmitting means transmits to a transmission destination the file registration information that describes the URL notation using electronic mail (see col.7, lines 41-43).

As per **claim 3**, which depends on claim 1, Schneider further teaches wherein the URL generating means generates URL notation that includes description to call a file name change function and/or storage folder change function (see col.1, line 63-col.2, line 7).

As per **claim 4**, which depends on claim 1, Freivald further teaches wherein the file posting apparatus is a Web filing system and the transmission destination is a terminal (see Fig.1).

As per **claim 5**, which depends on claim 1, Freivald further teaches wherein the file generating and registering means assigns the relevant file name to the generated file by using date and time information (implicit: see col.4, lines 15-19).

As per **claim 6**, which depends on claim 1, Freivald further teaches wherein the file generating and registering means uses a folder reported as a storage destination beforehand from the file posting apparatus as the storage destination of the generated file (see col.4, lines 7-17).

As per **claim 7**, which depends on claim 1, Freivald further teaches wherein the full path information in URL notation generated by the URL generating means is defined based on a filename assigned by the file generating and registering means and a determined storage folder (implicit: see col.3, lines 31-40).

As per **claim 8**, which depends on claim 1, Freivald and Schneider further teaches wherein the description to call a function which operates the file in URL notation generated by the URL generating means is a description that calls a function provided by a CGI program provided in the file posting apparatus (see Freivald: col.3, lines 31-40 and Schneider: col.1, line 63-col.2, line 7).

As per **claim 11**, which depends on claim 10, Freivald further teaches wherein the file registering means has a file transfer program to transfer the file to the file posting apparatus; and

wherein the transmitting means comprises a mail transmission program to transmit file registration information describing the URL notation to a transmission destination using electronic mail (see claim 2 rejection above).

Conclusion

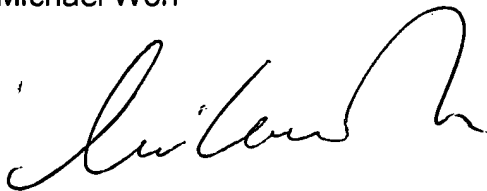
5. For the reasons above claims 1-11 has been rejected and remains pending.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Micháel Won



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER

February 3, 2006